

HITOSHI SAKASHITA  
USSN 09/904,347

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments attached and the following comments.

Claims 1, 2, 4-6 are pending. Claim 3 has been canceled. Amendments have been made to claims 1, 5 and 6. Support for the amendment of "randomly arranged" in claim 1 is found in the specification at page 7, lines 12-13. Support for the amended portion of claim 1 containing "metal fibers, metal-covered synthetic fibers, metal-covered glass fibers, or colored fibers" is found in original claim 3. The remaining amendment to claims 1, 5 and 6 are in response to the rejections under 35 U.S.C. 112, second paragraph. A mark-up showing the changes that have been made to these claims using brackets and underlining is attached. It is believed that no new matter has been added.

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Rejections under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 5 and 6 under 35 U.S.C 112, second paragraph, as being indefinite.

In response, Applicant points out claims 5 and 6 are not dependent upon claim 1. Rather, claims 5 and 6 incorporate the product limitation of claim 1. Accordingly, Applicant has clarified claim 5 by incorporating the product limitation of claim 1. Claim 6 has been amended to place it in patent practice format.

The Examiner notes that if claim 5 and/or 6 is made independent, the claims will be withdrawn from consideration as being drawn to a non-elected invention. Applicants respectfully request that the Examiner examine claims 5 and 6 along with the other claims. In this regard, Applicants note that it is customary to examine one process of use along with product claims.

If the Examiner requires restriction between claims 5 and 6 and the original product claims, then Applicants presume that the original product claims have already been constructively elected by original presentation. However, in that event, Applicants would call the Examiner's attention to the Commissioner's Notice published in the Official Gazette on March 26, 1996, at 1184 OG 86. According to that notice:

"[A]pplicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or the process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim

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depends from and otherwise includes all the limitations of an allowed product claim."

Applicants presume that the Examiner would then proceed in accordance with this notice, and that claims 5 and 6 would be rejoined and examined in the event that the original product claims were found to be allowable. If not, then Applicants would appreciate an explanation from the Examiner of why this notice is not applicable.

The Examiner also rejected claims 1-6 as being indefinite for the term "at the predetermined portion". In response, Applicant has amended the claim in accordance with the Examiner's suggestion.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 102

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by Akihiko (JP 09297917). The Examiner found the reference to teach a recordable magnetic powder to be broadly considered an identification element. In response, Applicants point out claim 1 has now been amended to include the limitation of original claim 3 which describes the identification elements as "metal fibers, metal-covered synthetic fibers, metal-covered glass fibers, or colored fibers". Since original claim 3 was not

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rejected by the Examiner and deemed free of the prior art under this portion of the statute, Applicant submits the claims are not anticipated by the reference.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 3 and 6 under 35 U.S.C. 103(a) as being obvious over Akihiko in view of Knight et al. (U.S. Patent No. 5,631,039). According to the Examiner, Akihiko did not disclose additional identification elements. The Examiner, however, found Knight to teach one or more security features into a card or document is old in the art, and that Knight discloses a detectable metal coated security thread. The Examiner ultimately found it would have been obvious to combine another security feature into the card of Akihiko in the form of a security thread.

In response, Applicant would remind the Examiner that the references must teach or suggest all the claim limitations. See MPEP §2143. Applicant submits a combination of the references would not have led a person of ordinary skill in the art to the present invention, because there is no suggestion in the references for the identification elements to be "randomly arranged" as claimed in amended claim 1. Knight contemplates its security feature to have a specific pattern that "provides both a visually discernible

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security feature and a magnetically detectable security feature". See e.g., abstract. Knight refers throughout the specification to a specific pattern formed by the magnetic metal and security thread. See e.g., col. 3, lines 21-23; col. 3, lines 50-54; claim 1 ("said security thread comprising a polymeric substrate supporting a pattern of magnetic material"). The reference clearly contemplates a pattern such as words or characters or a bar code. See col. 5, lines 53-67 until col. 6, lines 1-42. Accordingly, since the reference does not contemplate or suggest "randomly arranged" identification elements, the claims are not rendered obvious by the combination of the references.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By David D. Kim

David D. Kim

Reg. No. 53,123

113 2003  
220 East 42<sup>nd</sup> Street  
30<sup>th</sup> Floor  
New York, New York 10017  
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the attached Amendment to the Claims ( 9 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 12, 2003

By David D. Kim

David D. Kim